

REMARKS

Claims 1-18 and 21-22 were previously pending in the present application. Claims 1-3, 6-16, and 21 have been amended. Claims 23-25 have been added. Claims 4, 5, and 22 have been canceled. Thus, claims 1-3, 6-18, and 21-25 are pending upon entry of the above amendments.

Claims 1-3, 6-16, and 21 have been amended to clarify that the hydrolysates or condensates are compositions rather than compounds, because they are prepared in the presence of nanoparticles. See Example 4 of the present application. The resulting composition can be used as a curable clearcoat composition.

Claim 1 has been further amended by incorporating the limitations of claims 4-5, now canceled.

Restriction Requirement

Claims 1-18 and 21-22 are subject to a restriction requirement as follows:

Group I, Claims 1-15, 21-22, drawn to a compound

Group II, Claims 16-18, drawn to a process for preparing the compound. .

In response to the Examiner's Restriction, Applicants hereby elect prosecution of Group I, claims 1-15, 21-22, drawn to the composition, with traverse. This election is being made without prejudice to Applicants' rights with respect to the unelected claims, including the right to file divisional applications thereon.

It is the PTO's position that restriction is required between the inventions of Group I and Group II, because the common technical feature in all the groups is a compound comprising at least one of hydrolysate or condensate of epoxy- and silane-functional oligomers and polymers. The Office Action states that this feature is taught by Yamaya et al. (US 6,846,568), specifically as represented by the solution of a hydrolyzable silyl group-bearing acrylic polymer of working Example 3 that is formed from methacryloxypropyltrimethoxysilane and glycidyl methacrylate and subsequently subjected to hydrolysis and condensation of the acrylic polymer in an acidic medium (col. 23).

Applicants greatly appreciate the PTO's detailed comments but must respectfully disagree, in traversing the restriction requirement resulting in a provisional election of Group I.

The claims have now been amended to clarify that the common technical feature is that the composition is characterized in being prepared in the presence of at least one kind of nanoparticle. This common technical feature was pointed out in the PCT Written Opinion of the International Searching Authority, Box 5, para. 3. As indicated in the present application, the hydrolysis and /or condensation is conducted in the presence of nanoparticles which can be oxides, oxide hydrates, sulfates, hydroxides or phosphates of metals, wherein the nanoparticles have been surprisingly found useful as catalysts for the crosslinking of the hydrolysates or condensates of the invention. See para. [0070] to [0080] of the published application, US 2010/0137503.

It is respectfully submitted that the use of this combination of claimed components in a curable composition is a 'special technical feature' as that term is defined in MPEP 1893.03(d), i.e., meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

In view of the above, it is respectfully submitted that unity of invention does exist. Accordingly, restriction is not permissible under 37 CFR 1.499. Reconsideration and removal of the restriction requirement is respectfully requested.

Per the requirements of 37 CFR 1.499 and 37 CFR 1.43, however, Applicants hereby have elected the invention of Group I with traverse. If the restriction requirement is maintained, Applicants hereby authorize the cancellation of claims 16-18 as being drawn to a non-elected invention.

Yamaya et al. (hereafter "Yamaya") indeed discloses a copolymer derived from epoxy and silane-functional monomers that is polymerized in an acidic medium. However, the composition of Yamaya is used to make an anti-reflective multilayer laminate comprising a protective layer for other layers have specified refractive indices. Abstract and claim 1 of Yamaya. The protective layer can be prepared in an acidic medium comprising aluminum acetylacetone. Thus, nanoparticles required in the composition of the present claims are not taught by Yamaya.

New Claims

New claims 23-25 provide further definition of the nanoparticles as supported in the originally filed application corresponding to para. [0072]-[0074], [0076], and [0079] of the published application.

If the Examiner has any questions as to this response, the undersigned is available for a telephone conference at the number below.

Respectfully Submitted,

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